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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	.CONFIRMATION NO.
09/964,693	09/28/2001	Kenji Watanabe	Q66444	2941

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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

KRUER, KEVIN R

ART UNIT PAPER NUMBER

1773

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/964,693

Applicant(s)

WATANABE ET AL.

Examiner

Kevin R. Kruer

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: NONE
Claim(s) objected to: NONE
Claim(s) rejected: 1, 2, 4, 17 and 19-24
Claim(s) withdrawn from consideration: NONE

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: see attached.

Advisory Action

Applicant's arguments filed July 25, 2005 have been fully considered but are not persuasive. The proposed amendment has not been entered because it would raise new issues that would require further search and/or consideration. Specifically, the claims would be amended to contain limitations that have not previously been considered such as "transparent" moldings, moldings comprising antistatic layers on both sides of the base layer, and moldings wherein the intermediate and base layers are free of titanium compound. Furthermore, the amendments have not been entered because they are not deemed to place the application in better condition for appeal by materially reducing and/or simplifying the issues on appeal.

Since the proposed amendments have not been entered, Applicant's arguments with respect to said amendments are moot.

Applicant further argues JP'230 and JP'945 fail to disclose or suggest a molding that contains an intermediate layer comprised of a vinyl chloride resin having a degree of chlorination of 58-73%. The examiner agrees, but notes the rejections never relied upon said references for such a teaching. Rather, the examiner took the position the use of polyvinyl chlorides with said degree of chlorination was rendered obvious by said references. Applicant argues said references explicitly teach against the optimization of the degree of chlorination of the intermediate layer. Specifically, applicant argues paragraph (0039) of JP'230 clearly describes that vinyl chloride resins with a chlorination degree of 58% or more are excluded as being used as a surface layer. Applicant similarly points to paragraphs 0041 and 0045 in JP'945. Paragraph 0045

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does not discuss degrees of chlorination. Paragraph 0041 of JP'945 states vinyl chloride with a chlorination degree of 58% or more "is not desirable.... as a resin of a surface layer." With regard to the teachings of JP'230, the examiner notes that the surface layer taught in said reference is not the surface layer of the laminate proposed by the prior art combination relied upon in the rejection. The examiner, therefore, maintains the position that one of ordinary skill in the art would have been motivated to optimize the degree of chlorination of said layer for the reasons noted in the rejection. With regard to JP'945, the examiner notes that a reference may be relied upon for all the reference fairly suggests and is not limited to preferred embodiments.

Applicant further argues there is no motivation to alter the degree of chlorination of the surface layer. The examiner respectfully disagrees and maintains the position that one of ordinary skill in the art would have been motivated to alter the degree of chlorination for the reasons noted in the final rejection.

Applicant also argues that one of ordinary skill in the art would not have expected a vinyl chloride resin with a chlorination degree of 57% to have the same properties as a vinyl chloride resin with a chlorination degree of 58% or more. While the prior art teaches the degree of chlorination is a result effective variable, there is nothing on record that suggests a vinyl chloride with a chlorination degree of 57% would have substantially different properties in comparison to a vinyl chloride resin with a chlorination degree of 58%.

Applicant further argues PVC having a chlorination degree of 57% has different properties than a PVC having a chlorination degree of 58%. In an ordinary reaction,

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PVC is produced to have a chlorination degree of 56.8% (herein referred to as U-PVC).

A resin prepared by further chlorinating said PVC with chlorine gas is a chlorinated PVC and has a chlorination degree of 58% or more (herein referred to as C-PVC).

Accordingly, C-PVC requires additional steps for its production, is expensive in comparison to U-PVC, and has poor chemical resistance and processability. Applicant's summary of the prior art is noted. However, as noted by applicant (last line of the response mailed 12/3/04), the differences between U-PVC and C-PVC are well known by one skilled in the art. Thus, a skilled artisan was well aware of the differences between U-PVC and C-PVC and of the lamination technique taught in JP'230 utilizing both U-PVC and C-PVC in a manner that synergetically enhances the properties of said laminate. It would follow that the various laminates disclosed by applicant would have been obvious based upon the desired balance of properties.

Applicant argues the examiner's obviousness statement assumes one of ordinary skill in the art has a concept of what is a desired balance of properties and would know how to achieve the desired balance. The examiner initially notes that the prior art teaches how to achieve the desired balance of properties. Specifically, the prior art teaches the degree of chlorination can be tailored to achieve the desired properties. With regards to the argument that one of ordinary skill in the art may not have a concept of what is a desired balance of properties, the courts have taken the position that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." Thus, the courts have held that one of ordinary skill in the art does not necessarily have

to know the desired balance of properties as long as said properties are obtainable by routine experimentation.

With regard to claim 19, Applicant argues the teachings of JP'230 in view of Yoshizumi or Holley would not render the claim obvious in view of the teachings of JP'230 (paragraph 0039), breaks down conventional common sense, and lacks any motivation or suggestion for utilizing chlorinated polyvinyl chloride in place of the PVC taught in Yoshizumi. The examiner respectfully disagrees. Said combination of art teaches a PVC antistatic layer and that the degree of chlorination is a result effective variable. Therefore, the rejection is maintained.

With respect to claim 20, Applicant argues Holley does not teach a UV-curable or thermosetting resin. The examiner notes Holley was not applied to claim 20.

With respect to the rejection of claims 1, 2, 4, 17, 19, 20-22, and 24 as being obvious over JP'945 in view of Yoshizumi, Applicant's arguments with respect to the proposed amendments since said proposed amendments have not been entered.

Applicant's arguments with respect to JP'945 mirror the arguments made with respect to JP'230. Therefore, applicant's attention is directed to the examiner's comments above with regard to JP'230.

With regard to the rejection of claims 1, 2, 19, 20, and 21 as being obvious over JP'520 in view of Yoshizumi, the examiner notes Applicant admits the reference teaches an embodiment that reads on claim 2 (see page 44). Thus, the examiner maintains the position said reference renders the claimed invention obvious.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin R. Kruer
Patent Examiner-Art Unit 1773